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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,921	08/07/2001	Michael David Bell	CM2038	1887

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EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

11

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/890,921

Applicant(s)

MICHAEL DAVID BELL

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 & 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Examiner acknowledges receipt of IDS filed 01/18/02 and 05/28/02, request for extension of time filed 04/05/02, change of address filed 03/07/02 and 04/05/02 and amendment B filed 04/05/02. Claims 1-16 are pending.

Claims 15 and 16 were erroneously cancelled by entry of amendment A filed 08/07/01. However, according to the remarks in amendment B filed 04/05/05, claims 15 and 16 remain in the application. Claims 15 and 16 are thus considered and included in the action below.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd.

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App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites “number average molecular weight of greater than 50,000,” and the claim also recites “and especially greater than 100,000” which is another statement of the molecular weight limitation within the same claim.

It is suggested that a proper Markush language of “selected from the group consisting of” be employed in claim 8.

3. Claims 15 and 16 provides for the use of “a cation containing polymer” and “a composition comprising a polymeric thickening agent” respectively, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 15 and 16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

It is suggested that a proper Markush language of “selected from the group consisting of” be employed in claims 15 and 16.

#### ***Claim Rejections - 35 USC § 102***

4. Claims 1-5 remain rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al. (WO 96/03967). Claims 15 and 16 are included in this rejection.

***Claim Rejections - 35 USC § 103***

5. Claims 6-14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (WO 96/03967).

Applicants agree that the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) are improper and should be withdrawn because the composition disclosed in Jones is a hair fixative composition that holds the hair in a set style while the composition claimed in the application provides a water barrier over the skin. Applicants state that the composition of Jones is not a skin care composition. Applicants further agree that the water swellable polymers of the application cannot provide adequate hair styling benefits because the water swellable polymers of the application have inherent glass transition temperature or T<sub>g</sub>; furthermore, the water swellable polymers of the invention provide the water barrier essential in the application.

6. Applicant's arguments filed 04/05/02 have been fully considered but they are not persuasive.

In response to applicants' arguments that the composition of the prior art is a hair fixative composition rather than a skin care composition, it is noted that the application generally claims a composition and future intended use is not critical in a composition claim. Head hair is on the scalp, which is skin, and body hair is on the skin. The composition of the prior art is not prevented from getting on the scalp (skin) when the leave-in hair cosmetic composition such as the gels or cream of the prior art is applied to the hair. Specifically, Jones teaches that the hair composition provides reduced on-hair and on-hand tack (page 9, lines 2 and 3 of paragraph 1).

Secondly, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,

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water barrier over the skin and inherent glass transition temperature) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thirdly, the polymeric materials taught in the prior art are water swellable and are not different than those in the application because the polymeric materials taught in the prior art are the same as those in the application.

A summary of the rejections is presented below.

**A. Rejection under 35 U.S.C. 102(b)**

Jones discloses a cosmetic composition comprising a gelling agent and conditioning polymer (abstract and page 1, lines 3-7). The gelling agent comprises copolymer of methyl vinyl ether/maleic anhydride that is cross-linked with C<sub>4</sub>-C<sub>16</sub> alkadiene (PVM/MA decadiene crosspolymer) (page 2, lines 26 to page 3 line 34). The composition further comprises hair fixative polymer that are cationic copolymer of hydroxyethyl cellulose and diallyl dimethyl ammonium chloride known as POLYQUATERNIUM 4 (page 2, lines 30-32 and page 5, lines 24-35). The composition also contains carrier selected from C<sub>1</sub>-C<sub>6</sub> alkanols, carbitol, acetone and mixtures thereof (page 5, lines 11-15). Cationic and non-ionic resins, and any polymer, cationic or non-ionic, having molecular weight in the range from about 1,000 to 5,000,000, and which is soluble or colloidally dispersible in the cosmetic carrier may be utilized as the hair fixative polymer (page 6, lines 8-33 and page 7). Cationic polysaccharides, guar gum and homopolymers and copolymers derived from acrylic acid and/or methacrylic acid are examples of polycationic polymer resins utilized in the composition (page 7, lines 32 to page 8 line 3).

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The composition comprises from about 0.1% to about 10% by weight of hair fixative polymer (page 2, lines 31-33). The composition of Jones can be formulated as leave-in hair cosmetic compositions such as gels or creams (page 8, lines 11-14). Jones teaches that the hair composition provides reduced on-hair and on-hand tack (page 9, lines 2 and 3 of paragraph 1). The composition optionally contains preservatives, surfactants, block copolymers, thickeners and viscosity modifiers (page 8, lines 26-35). See also claims 1-12.

The invention is directed to a cosmetic composition comprising i) a polymeric thickening agent selected from non-ionic and anionic thickening agents or mixtures thereof, having average molecular weight greater than 20,000 and ii) a cation containing polymer, or mixtures thereof where the composition comprises less than 4% of an anionic, zwitterionic or amphoteric surfactant. The surfactant in the composition of the instant invention is less than 4% and 0% is less than 4%.

The prior art teaches optional surfactant and anionic, zwitterionic or amphoteric surfactant is encompassed in the generic disclosure of surfactant. **It may be noted that the polymeric materials taught in the prior art are the polymeric materials taught in the invention.** Thus Jones meets the limitations of claims 1-5 and 15-16.

**B. Rejection under 35 U.S.C. 103(a)**

The amount of the polymeric thickener or hair fixative polymer (from about 0.1% to about 10%) taught in the prior art differs from that recited (from about 0.01% to about 20%) in the application. However, it is noted that the amount of the polymeric thickener (from about 0.1% to about 10%) taught in Jones lies within the range taught in the invention (from about 0.01% to about 20%). And in the case where the claimed ranges "overlap or lie inside ranges

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disclosed by the prior art" a prima facie case of obviousness exists, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones to prepare a hair composition comprising from about 0.1% to about 10% of polymeric thickener that is selected from cationic and non-ionic resins, cationic or non-ionic polymer, having molecular weight in the range from about 1,000 to 5,000,000, and which is soluble or colloidally dispersible in the cosmetic carrier and cationic copolymer of hydroxyethyl cellulose and diallyl dimethyl ammonium chloride known as POLYQUATERNIUM 4, and carrier selected from C<sub>1</sub>-C<sub>6</sub> alkanols, carbitol, acetone and mixtures thereof. One having ordinary skill in the art would have been motivated to prepare a leave-in hair fixative composition comprising from about 0.1% to about 10% of polymeric thickener since Jones teaches that a composition comprising from about 0.1% to about 10% of polymeric thickener reduces on-hair and on-hand tack.

The expected result is a leave-in hair fixative composition, comprising from about 0.1% to about 10% of polymeric thickener that is selected from cationic and non-ionic resins, cationic or non-ionic polymer, having molecular weight in the range from about 1,000 to 5,000,000, and which is soluble or colloidally dispersible in the cosmetic carrier and cationic copolymer of hydroxyethyl cellulose and diallyl dimethyl ammonium chloride known as POLYQUATERNIUM 4, and carrier selected from C<sub>1</sub>-C<sub>6</sub> alkanols, carbitol, acetone and mixtures thereof, that reduces on-hair and on-hand tack.



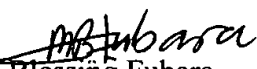
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7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

  
Blessing Fubara  
Patent Examiner  
Tech. Center 1600  
June 28, 2002